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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,626	10/24/2003	Mark J. Verkamp	3818.00	7191
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EXAMINER				
A. PHU DIEU TRAN				
ART UNIT		PAPER NUMBER		
3633				
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03/10/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/691,626

Applicant(s)

VERKAMP, MARK J.

Examiner

PHI D. A

Art Unit

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“ can be formed” confuses the scope of the claim.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Morris et al (5947817).

Morris et al shows a spacer (312), the spacer comprising a strip of resilient foam, the resilient foam comprising polyethylene, the strip of foam can be formed into a roll for convenient storage and transport prior to use.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al.

Morris et al shows all the claimed limitations except for the spacer having a width of about 3 inches and the height of about ¼ inch.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Morris et al's spacer to show the spacer having a width of about 3 inches and the height of about ¼ inch because it would have been an obvious matter of engineering design choice to choose the spacer dimension to have a width of about 3 inches and height of about ¼ inch to fit a particular application, and a change in size is generally recognized as being within the level of ordinary skill in the art, In re Rose, 105 USPQ 237 (CCPA 1955).

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (6907701) in view of Berger (4446665).

Smith shows a method of re-roofing a roof having multiple rows of shingles (22), the method comprising the steps of positioning a first strip of resilient foam (14) atop the exposed portion of one row of asphalt shingles (22, col 4 lines 52-54), the first strip of foam having a height sufficient to project above the tops of the shingles in adjacent rows, positioning a second strip of resilient foam (14) atop the exposed portion of another row of asphalt shingles, the second strip of resilient foam having a height sufficient to project above the tops of the shingles

in adjacent rows, positioning a corrugated metal panel (16) atop the first, driving a penetrating fastener through the metal panel so as to attach the metal panel to the roof (fastened thereto by a nail driving through the panel to attach to the roof).

Smith does not show the step of positioning the metal panel atop both the first and second strips.

Berger discloses positioning a roof panel (18) on first and second strips (43) to cover the strips.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Smith's structure to show the step of positioning the metal panel atop both the first and second strips as taught by Berger because having a metal panel positioning on multiple strips at the same time would allow for the fast covering of the entire roof structure as each large piece of metal roof covers more roof space than the smaller pieces.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith(6907701) in view of Vasquez (5471807).

Smith shows a joist (figure 1, the part supporting the roofing surface 12), a deck (12) supported by the joist, a plurality of rows of shingles (22) positioned atop the deck, a resilient spacer (14) positioned atop one of the rows of shingles and projecting above adjacent rows of shingles, a corrugated metal roof panel (16) positioned atop the spacer and separated from the rows of shingles by the spacer.

Smith does not show an underlayment between the deck and the shingles.

Vasquez shows an underlayment (14) positioned between the deck (12) and the shingles (20).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Smith's structure to show an underlayment between the deck and the shingles as taught by Vasquez because the underlayment would provide added protection to the roof against the elements as taught by Vasquez.

Response to Arguments

7. Applicant's arguments with respect to claims 1-5, 7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different spacer designs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3633

/Phi D A/

Examiner, Art Unit 3633

Phi Dieu Tran A

2/19/08